



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Patent Cooperation Treaty Legal Office

Address: Assistant Commissioner for Patents
Box PCT
Washington, D.C. 20231

JUN 07 2000

Mary Rose Scozzafava
CLARK & ELBING
176 Federal Street
Boston, MA 02110

In re Application of
LEE, et al.

Application No.: 09/284,297

PCT No.: PCT/US97/18631

Int. Filing Date: 16 October 1997

Priority Date: 16 October 1996

Attorney Docket No.: 04712/02000G

For: METHOD OF PREPARING A POORLY
CRYSTALLINE CALCIUM PHOSPHATE
AND METHOD OF ITS USE

:
:
:
: DECISION ON PETITION
:
: UNDER 37 CFR 1.48(a)
:
:
:
:

This decision is in response to applicants' "REPLY TO NOTIFICATION OF A DEFECTIVE RESPONSE" and "PETITION TO CORRECT INVENTORSHIP PURSUANT TO 37 CFR 1.48(a)" filed 25 February 2000. The required fee of \$130 under 37 CFR 1.17(i) for this petition has been submitted.

BACKGROUND

On 16 October 1997, applicants filed international application No. PCT/US97/18631 which claimed a priority date of 16 October 1996, and which designated the United States. The international application named Dosuk D. Lee, Christian Rey and Maria Aioloa as inventors. A Demand for international preliminary examination was filed on 15 May 1998, prior to 19 months from the priority date. Accordingly, the thirty-month period for paying the basic national fee expired at midnight on 16 April 1999.

On 12 April 1999, applicants filed a transmittal letter for entry into the national stage accompanied by, *inter alia*, the requisite basic national fee, and a copy of the international application.

On 18 June 1999, applicants filed a combined declaration and power of attorney signed by Dosuk D. Lee, Christian Rey, Maria Aioloa and Aliassghar Tofighi.

On 01 February 2000, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) and Notification of a Defective Oath or Declaration (Form PCT/DO/EO/917) indicating that the declaration was not executed in accordance with 37 CFR 1.66 or 37 CFR 1.68. The notification set a one-month time limit to respond.

On 25 February 2000, applicants filed a "Reply to Notification of a Defective Response" and a "Petition to Correct Inventorship Pursuant to 37 CFR 1.48(a)" to add Aliassghar Tofighi as an inventor. Accompanied the petition, applicant filed: Notification of the Recording of a Change (Form PCT/IB/306); Petition To Correct Inventorship -- Consent of Assignee; Petition To Correct Inventorship -- Declaration of Inventor executed by Aliassghar Tofighi, Dosuk Lee; Christian Rey; and Maria Aioloa; Petition To Correct Inventorship -- Declaration of Inventor Agreeing to Correction executed by Aliassghar Tofighi, Dosuk Lee; Christian Rey; and Maria Aioloa; a combined declaration and power of attorney executed by Aliassghar Tofighi, Dosuk Lee; Christian Rey; and Maria Aioloa; and an assignment.

DISCUSSION

In order to correct an error in naming the inventor(s) made during the international stage in the national stage, a petition under 37 CFR 1.48(a) or a showing that a 92bis change was made prior to the National stage filing is required. In the instant case, applicants have provided a Notification of the Recording of a Change (Form PCT/IB/306) indicating that Aliassghar Tofighi has been added as an inventor prior to entering into the national stage in the United States of America.

A review of the declarations filed on 13 July 1999 (and declarations thereafter) are defective and is therefore insufficient to satisfy the oath or declarations requirement of 35 CFR 371(c)(4) for entry into the national stage in the United States of America. Specifically, the declaration submitted includes two sheets numbered 2 of 3.

CONCLUSION

For the reasons discussed above, applicants' petition under 37 CFR 1.48(a) is **DISMISSED** as moot. The petition fee under 37 CFR 1.17(i) has been refunded to Deposit Account No. 03-2095.

A proper response must be filed within **ONE (1) MONTHS** from the mail date of this decision. Extensions of time may be obtained under 37 CFR 1.136(a). Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.48(b)." No additional petition fee is required.

A proper response must include a proper declaration in compliance with 37 CFR 1.497 (a) and (b) executed by all of the named inventors.

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.



Leonard Smith
PCT Legal Examiner
PCT Legal Office



Anthony Smith
Petitions Attorney
PCT Legal Office
Tel.: (703) 308-6314
Fax: (703) 308-6459